



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

A

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,883	07/21/2003	Robert R. Parsons	15569-0005	6790
28529	7590	12/16/2005	EXAMINER	
GALLAGHER & KENNEDY, P. A. 2575 E. CAMELBACK RD. #1100 PHOENIX, AZ 85016			BAROT, BHARAT.	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,883	PARSONS ET AL.	
	Examiner Bharat N. Barot	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34, 44-47 and 52-70 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-34, 44-47, and 52-70 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

RESPONSE TO AMENDMENT

1. Claims 1-34, 44-47, and 52-70 remain for further examination.

Claim Objection

2. Claim 1 is objected to because of the following informalities: Claim 1 contain “.” in line 9 step (iv), which is a typographical error and “.” Should be --,--.

Appropriate correction is required.

The new grounds of rejection [Claim Rejections - 35 USC § 101]

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 26-34 and 44-47 are rejected under 35 U.S.C. 101 because the claimed invention of the claims 26-34 and 44-47 is directed to non-statutory subject matter.

Claim 26 recited “A domain name by proxy computer program comprising:” and claim 44 recited “Programming for a proxy entity in a proxy domain name registration system including:” which are adapted to perform some steps. The computer program and the programming are non-statutory as not being tangibly embodied in computer readable medium in a manner so as to be executable, and also claimed that the computer program/programming execute in a computer or by a computer are descriptive material per se and are not statutory because they are not capable of causing functional change

in the computer (See MPEP section 2106, Seventh Edition, Revision No. 1 dated February 2000, at page 2100-10 and 2100-11).

Other dependent claims, which are not specifically cited above are also rejected because of the deficiencies of their respective parent claims.

The old rejection maintained

5. Applicant's arguments with respect to claims 1-34, 44-47, and 52-70 filed on August 29, 2005 have been fully considered but they are not deemed to be persuasive for the claims 1-34, 44-47, and 52-70. The modify rejection is made in view of Gardos et al (U.S. Patent No. 6,880,007).

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-34, 44-47, and 52-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardos et al (U.S. Patent No. 6,880,007). Gardos' patent meets all the limitations for the claims 1-34, 44-47, and 52-70 recited in the claimed invention.

8. As to claim 1, Gardos et al disclose a proxy domain name registration system (see abstract; and figures 1-3) comprising: a registrar (153) for receiving domain name registration requests from customers (registrants) (1), communicating a registration request to a registry (8) including a domain name and domain owner personal contact

information, communicating a domain name and personal contact information to a proxy domain owner, and storing domain owner contact information (figures 4-6; and columns 10-12); a proxy (web server with domain manager) (150,160) for receiving and storing personal contact information communicated to the proxy by the registrar, and communicating proxy personal contact information to the registrar; and the registrar being responsive to the communication of personal contact information by the proxy to: submit a registration request and the proxy personal contact information from the proxy to a registry (figures 4-6; and column 10-12), and store that proxy contact information in the storage (figure 3; column 6 lines 26-50; column 7 lines 1-36; column 7 line 57 to column 8 line 25; and column 8 line 52 to column 9 line 29).

9. As to claims 2-3, Gardos et al disclose that the proxy for enabling the customer to signal a command to cancel proxy registration and responding to the customer's signal of the command to cancel for automatically causing transfer of ownership to the customer by the registrar (figure 3 and 4B; column 7 line 57 to column 8 line 11; column 9 lines 16-29; and column 10 lines 33-51).

10. As to claims 4-6, Gardos et al disclose that the proxy for passing email along to the customer and blocking one or more categories of email from reaching the customer, wherein the categories of email are selected from the group consisting of SPAM, unauthorized bulk email, unauthorized commercial email and pornography (column 2 line 45 to column 3 line 14; and column 10 lines 19-51).

11. As to claims 7-11, they are also rejected for the same reasons set forth to rejecting claims 1-6 above. Additionally, Gardos et al disclose that (claim 7) the registrar establishing a web site; an interactive page on the web site enabling a customer to request the registration of a domain name; a message on a page on the Web site prompting a customer to indicate whether proxy registration of a domain name is desired; and a field on a page of the web site for a customer to enter a desired domain name (figure 4A; column 8line 52 to column 9 line 29; and column 9 line 66 to column 10 line 51), (claim 9) the communication input at the proxy is a proxy web site having an interactive page enabling a customer to indicate cancellation of proxy registration (figure 4B; and column 10 lines 19-51), and (claim 11) a proxy email server adapted to receive email, the proxy information including a proxy email address, the registrar publishing the proxy email address in association with a domain name, whereby email intended for the customer is directed to the proxy email server (figures 4S; column 3 lines 14-57; and column 8 lines 25-32).

12. As to claims 12-18, they are also rejected for the same reasons set forth to rejecting claims 1-6 above, since claims 12-18 are merely a method of operation for the apparatus defined in the claims 1-6. Additionally, Gardos et al teach that directing to the proxy electronic communications addressed to a domain name registered by proxy (column 10 lines 52-63).

13. As to claims 19-25, they are also rejected for the same reasons set forth to rejecting claims 1-6 above, since claims 19-25 are merely a method of operation for the apparatus defined in the claims 1-6. Additionally, Gardos et al teach that receiving electronic addressed to the domain name and sending electronic communications from the domain name, absent identification of the customer (column 9 line 48 to column 10 line 17).

14. As to claims 26-34, they are also rejected for the same reasons set forth to rejecting claims 1-11 above, since claims 26-34 are merely a computer program for the apparatus defined in the claims 1-11. Additionally, Gardos et al disclose that the proxy information stored in memory includes proxy contact information, wherein the proxy contact information includes proxy email address; and teach that communicating with a proxy includes programming for forwarding to the proxy customer information, wherein the customer information includes customer contact information and customer email address (figures 4A-4B; and column 8 line 52 to column 10 line 63).

15. As to claims 44-47, they are also rejected for the same reasons set forth to rejecting claims 1-11 above, since claims 44-47 are merely a computer program for the apparatus defined in the claims 1-11.

16. As to claims 52-59, they are also rejected for the same reasons set forth to rejecting claims 1-6 and 26-34 above, since claims 52-59 are merely a method of

operation for the apparatus defined in the claims 1-6 and for the computer program defined in the claims 26-34. Additionally, Gardos et al teach that contractually granting legal rights in the domain name to the customer and the domain name, the proxy registration request and personal information from the customer are received from the customer via an interactive web site (figures 4A-4B; and column 8 line 52 to column 10 line 63).

17. As to claims 60-68, they are also rejected for the same reasons set forth to rejecting claims 1-6, 26-34, and 52-59 above, since claims 60-68 are merely an apparatus for the method of operation defined in the claims 52-59 and for the computer program defined in the claims 26-34.

18. As to claims 69-70, they are also rejected for the same reasons set forth to rejecting claims 7-8 above,

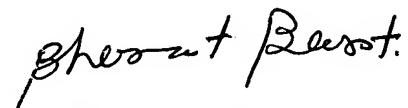
Response to Arguments

19. Applicant's arguments with respect to claims 1-34, 44-47, and 52-70 filed on August 29, 2005 have been fully considered but they are not deemed to be persuasive for the claims 1-34, 44-47, and 52-70. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the modified office action.

Contact Information

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.



BHARAT BAROT
PRIMARY EXAMINER

Patent Examiner Bharat Barot

Art Unit 2155

December 02, 2005